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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,313	01/23/2004	Masanori Nakahara	041465-5106-01	4644

55694 7590 05/22/2006

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EXAMINER

TRAN, THANG V

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/762,313	Applicant(s) NAKAHARA ET AL.	
	Examiner Thang V. Tran	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-52 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 19,24-28,33-36,41-45 and 50-52 is/are rejected.
- 7) ☒ Claim(s) 20-23,29-32,37-40 and 46-49 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/823,980.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

The communication filed 04/05/06 has been considered with the following results:

Election/Restrictions

1. The Requirement for Restrictions dated 03/06/06 is hereby withdrawn and claims 19-52 are considered as follow:

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 19, 27, 28, 36, 44 and 45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,724,703. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-18 of the U.S. Patent No. 6,724,703 include all limitations recited in claims 19-52 of a present application. See the corresponding claims of the present application and the U.S. Patent No. 6,724,703 listed below.

Claims in the present application

Claims in the U.S. Patent No. 6,724,703

19	1 or 2
27, 28	1 or 2
36	1, 2, 10 or 11
44, 45	1, 2, 10 or 11

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 27-35 and 44-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 27, claim 27 recites an information editing apparatus of editing recording information recorded on an information recording medium, but it is unclear from the claim as to how the recorded information is edited without being reading out from the recording medium; there is no source or device provided in the claim to perform the editing function; and it is also unclear from the claim where control information generated by generating device goes or why control information is generated since it has never been used later in the claim.

As per claim 44, see the rejection applied to claim 27 above.

Claims 28-35 and 43-52 fall with their respective parent claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 19- are rejected under 35 U.S.C. 102(b) as being anticipated by Okada (US 5,810,600).

Regarding claim 19, see Figs. 106 of Okada which disclose an information recording apparatus (see Figs. 1 and 2) for recording information on an information recording medium (hard disk or optical disk in recorder 2), comprising: a detecting device (5) which detects a division timing (silent or boundary portion) in the recording information; a recording device (2) which records former part recording information which is the recording information before the division timing and latter part recording information which is the recording information after the division timing, on the information recording medium, and a generating device which generates control information including former control information corresponding to the former part recording information (start address and end address) and latter control information corresponding to the latter part recording information (start address and end address), wherein the recording device records the control information on the information recording medium (see column 20, lines 39-57).

Regarding claim 24, see the function of key 26 for limitations recited in this claim.

Regarding claims 25 and 26, see column 20, line 39-50, and column 21, line 66 to column 22, line 5, for limitations recited in this claim.

Regarding claims 27 and 28, see the rejection applied to claim 19.

Regarding claim 33, see the rejection applied to claim 24.

Regarding claim 34 and 35, see the rejection applied to claims 25 and 26.

Regarding claim 36, see the rejection applied to claim 19.

Regarding claim 41, see the rejection applied to claim 24.

Regarding claims 42 and 43, see the rejection applied to claims 25 and 26.

Regarding claims 44 and 45, see the rejection applied to claim 19.

Regarding claim 50, see the rejection applied to claim 24.

Regarding claims 51 and 52, see the rejection applied to claims 25 and 26.

Allowable Subject Matter

8. Claims 20-23 and 37-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 29-32 and 46-49 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Claims 20-23, 29-32, 37-40 and 46-49 are allowable over the prior art of record because all of references of record, viewed as closest prior art and considered in combination or individually, fails to suggest or fairly teach an information recording or editing apparatus or method including a combination of all limitations as particularly recited in each of claims 20-23, 29-32, 37-40 and 46-49.

Cited References

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references relate to a recording/editing device for an information recording medium on which a plurality of portions of divided data are recorded.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thang V. Tran whose telephone number is (571) 272-7595. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nguyen Hoa can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thang V. Tran
Primary Examiner
Art Unit 2627